

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	
)	
Douglas W. Akers)	Examiner: Ricardo J. Palabrica.
)	
Serial No.: 10/788,743)	Group Art Unit: 3663
)	
Filing Date: February 25, 2004)	Conf. No.: 6111
)	
For: METHOD FOR ON-LINE EVALUATION)	Atty. Docket No.: B-200
OF MATERIALS USING PROMPT)	
GAMMA RAY ANALYSIS)	

REPLY BRIEF

To: Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the October 15, 2007 Examiner's Answer, Appellant submits this Reply
Brief in accordance with 37 C.F.R. § 41.41.

STATUS OF THE CLAIMS

Claims 1-10, 12-19 and 21-23 are pending in the application. Claims 11, 20 and 24 are cancelled. Claims 1-10, 12-19 and 21-23 currently stand rejected. The rejections of claims 1-10, 12-19 and 21-23 are appealed.

In the present application, the Examiner provisionally rejected claim 2 under the judicially-created doctrine of double patenting over claim 3 of co-pending divisional application, serial no. 10/383,096. Appellant did not traverse this provisional rejection and has agreed to file the appropriate terminal disclaimer in the appropriate application at the appropriate time (i.e., upon the indication of allowance of either claim 2 in this application or claim 3 of the co-pending application).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-10, 12-19 and 21-23 are patentable under 35 U.S.C. §112, first paragraph, as complying with the enablement requirement.
2. Whether claims 12-19 and 21-23 are unpatentable under 35 U.S.C. §112, first paragraph, as not enabled for failing to include critical elements.
3. Whether claims 1-10, 12-19 and 21-23 are patentable under 35 U.S.C. §112, second paragraph, as distinctly claiming the subject matter of the invention.
4. Whether claims 12-19 and 21-23 are unpatentable under 35 U.S.C. §112, second paragraph, for failing to include critical elements.

ARGUMENT

Any of the Examiner's arguments that are not addressed in this Reply Brief have already been set forth in the Appeal Brief. Therefore, the Appellant's failure to respond in this paper should not be considered as acquiescing in the Examiner's reasoning.

The Examiner has added to the grounds for the rejection in the Examiner's Answer. The new grounds of rejection attempt to present the arguments in a different light by citing the MPEP and case law. However, the Examiner's arguments are incorrect and no stronger than the ones originally presented for the reasons below.

I. Whether claims 1-10, 12-19 and 21-23 are patentable under 35 U.S.C. §112, first paragraph, as complying with the enablement requirement.

On pages 5 and 6 of the Examiner's Answer, the Examiner cited MPEP § 2146.06, § 2146.06(a), *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971) and *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974). These sections of the MPEP point out that enablement is questionable when a block diagram is used in place of showing how computers are meshed together with other parts of a system, method or device. MPEP § 2164.06(c), which cites *In re Ghiron* and *In re Scarbrough*, points out that some cases involve the art of computer programming meshed with another technology. For example, in *In re Scarbrough*, the court reviewed the block diagrams to determine "whether complex elements known to perform broadly recited functions in different systems would be adaptable for use in appellant's particular system with only a reasonable amount of experimentation." *In re Scarbrough*, 500 F.2d at 566. In *In re Ghiron*, the court took issue with the block diagrams in the application because "the method in issue cannot be performed by a general purpose computer of the prior art. [Ghiron et al] concede as much in stating that their invention 'is a modification to prior art overlap computers.'" *In re Ghiron*, 442 F.2d at 991.

Unlike these cases, the Examiner rejects the claims because of undue experimentation with an algorithm that is admittedly well-known (Office Action (1/16/07), p. 18). The issues on appeal do not involve meshing of one computer system with another system; nor do the issues involve modification of prior art computers.

Instead of analyzing the undue experimentation factors of MPEP § 2164.01(a); *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988), the Examiner has cited a case where it was questionable whether “functions in different systems would be adaptable for use in appellant’s particular system with only a reasonable amount of experimentation” and a case where modification of prior art “overlap mode” computers is required. *In re Scarbrough*, 500 F.2d at 566; *In re Ghiron*, 442 F.2d at 991.

Accordingly, these new grounds for rejection do not bolster the Examiner’s argument.

II. Whether claims 12-19 and 21-23 are unpatentable under 35 U.S.C. §112, first paragraph, as not enabled for failing to include critical elements.

For the first time, on page 12 of the Examiner’s Answer, the Examiner takes issue with the phrase “evaluating a material specimen” in the preamble of claims 12-19 and 21-23. The Examiner essentially argues that because the preamble recites “evaluating a material specimen,” the claims lack a critical data processing step and outputs have to be processed by an algorithm. As explained on pp. 28-30 of Appellant’s Brief, the specification describes embodiments that do not require a data processing step. Appellant has characterized the method for evaluating a material specimen as omitting a data processing step in the abstract and ¶ 71 of the specification, for example. Appreciably, the abstract begins “A method for evaluating a material specimen ...” and proceeds to detail the inventive method that omits a data processing step. If Appellant chooses to call this inventive method a “method for evaluating a material specimen,” there is

nothing in the MPEP or case law to prevent him from using such a phrase; especially since it is explained in the specification.

III. Whether claims 1-10, 12-19 and 21-23 are patentable under 35 U.S.C. §112, second paragraph, as distinctly claiming the subject matter of the invention.

On page 14 of the Examiner's Answer, the Examiner states "the appellant claims a 'non-destructive testing method' that STOPS with the collection of raw data." By putting "non-destructive testing method" in quotations, the Examiner appears to be stating that the claims recite "non-destructive testing method." While the specification explains that the invention relates to "methods ... for performing non-destructive testing" in ¶ 3, nowhere in the claims is "non-destructive testing method" recited. Furthermore, claims 1-10, 21 and 22 do not stop with the collection of raw data and further recite a data processing step.

The Examiner then proceeds to state that "there is an inconsistency with the specification and/or prior art teachings that render the claims indefinite (see MPEP 2173.03)." MPEP § 2173.03 sets forth an "unreasonable degree of uncertainty" threshold. As explained on pp. 28-30 of Appellant's Brief, there is no inconsistency between the claims and the specification. Since there is no inconsistency between the claims, there is certainly not an unreasonable degree of uncertainty.

The Examiner also states on page 14 of the Examiner's Answer that "the preamble (which is directed to a non-destructive testing method) is being given a meaning contrary to its ordinary meaning (MPEP 2173.05(a), part III)." The preamble does not recite "a non-destructive testing method." Rather, the preamble recites "a method for evaluating a material specimen." The specification at, for example, the abstract and ¶ 71 explain the method for evaluating a material specimen. Even if Appellant was using a term contrary to its ordinary meaning (which

is denied), MPEP § 2173.05(a) III. allows this if the written description clearly defines the terms. As explained at pp. 28-30 of Appellant's Brief, the specification clearly explains what is meant by a method for evaluating a material specimen.

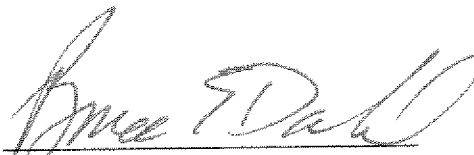
IV. Whether claims 12-19 and 21-23 are unpatentable under 35 U.S.C. §112, second paragraph, for failing to include critical elements.

On pages 20-22 of the Examiner's Answer, Appellant is accused of taking inconsistent positions on two co-pending applications. Appellant has *not* taken inconsistent positions. First, the instant application is a continuation-in-part application (CIP). The claims of a CIP commonly have a different scope than the parent application. This is not inconsistency. It is exercising the right to pursue claims of different scope and content. Second, pointing out that Appellant has claimed a calculating step in a parent application of a CIP is not cogent reasoning that a critical element is missing. The lack of cogent reasoning also speaks to why the subject matter of the parent application is not material to patentability of the CIP. Finally, while the MPEP states that Appellant cannot assume that the Examiner is aware of other applications, Appellant wishes to point out that the instant Examiner is in charge of both applications and is clearly familiar with both applications since prosecution has been re-opened on December 11, 2007 after the filing of a reply brief on April 13, 2006.

Conclusion

In view of the above arguments and further in view of the arguments in the March 22, 2007 Appeal Brief, the rejections of claims 1-10, 12-19 and 21-23 should be reversed.

Respectfully submitted,

By: 

Bruce E. Dahl, Esq.
Attorney for Appellants
PTO Registration No. 33,670
Fennemore Craig, P.C.
1700 Lincoln Street, Suite 2900
Denver, CO 80203
(303) 291-3200

Date: 12-17-07